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U.S. Application No. 09/752,267 Art Unit 2614  
Response to February 7, 2005 Office Action

### **REMARKS**

In response to the Office Action dated February 7, 2005, Assignee respectfully requests reconsideration based on the above claim amendments and the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited documents.

The United States Patent and Trademark Office (the "Office") objected to the drawings. Claim 29 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Claims 1-4, 6-7, 10, 15-16, 19, and 30-32 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,240,555 to Shoff *et al.* Claim 5 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Shoff in view of Published U.S. Patent Application 2002/0073424 to Ward *et al.* Claims 8-9, 12-14, 18, and 24-25 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Shoff in view of U.S. Patent 6,008,802 to Iki *et al.* Claims 11, 17, and 33 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Shoff in view of U.S. Patent 6,326,982 to Wu *et al.* Claims 20-23 and 28-29 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Shoff in view of U.S. Patent 6,597,405 to Iggulden. Claims 26-27 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Shoff. The Assignee shows, however, that the amended claims are neither obviated nor anticipated by the cited documents. The Assignee thus respectfully submits that the pending claims distinguish over the cited documents.

### **Objection to the Drawings**

The United States Patent and Trademark Office (the "Office") objected to the drawings. The Office specifically objected to an incorrect reference numeral at page 11, line 8 of the specification. Rather than submit corrected drawings, however, the Assignee will simply correct the reference numeral in the specification. Examiner Ma is thanked for noting this mistake.

### **Rejection of Claim 29 under 35 U.S.C. § 112**

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Claim 29 was rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Claim 29 has been amended to correctly depend from claim 1. Examiner Ma is again thanked for the keen eye.

### **Rejections under 35 U.S.C. § 102**

Claims 1-4, 6-7, 10, 15-16, 19, and 30-32 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,240,555 to Shoff *et al.* A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P."). As the Assignee shows, the amended claims patentably distinguish over *Shoff*. The reference to *Shoff* does not anticipate the claims, so the Assignee respectfully requests that Examiner Ma to remove the 35 U.S.C. § 102 (e) rejection.

The claims have been amended. A data tag is received with programming. The data tag is stripped from the programming, and control data is then communicated to a consumer electronics device to supplement the programming. Amended claim 1, for example, is reproduced below.

1. (Currently Amended) A method of distributing tagged programming, the method comprising:

~~receiving providing~~ programming to a communications network; and  
~~receiving communicating~~ a data tag with the programming, wherein the data tag  
~~comprising comprises~~ control data information relating to the programming;  
~~stripping the data tag from the programming; and~~  
~~communicating the control data to a consumer electronics device to supplement~~  
~~the programming.~~

Independent claims 16 and 30 include similar features.

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Independent claim 10 has also been amended. Claim 10 communicates a data tag that has been added to electronic program guide data. The data tag comprises a command and a parameter. The command comprises an instruction to send a control instruction to a consumer electronics device. Amended claim 10 is reproduced below.

10. (Currently Amended) A method of distributing tagged programming, comprising:
- communicating electronic program guide data via a communications network;
  - and
  - communicating a data tag that has been added to the electronic program guide data, the data tag comprising a command and a parameter, the command comprising an instruction to send a control instruction to a consumer electronics device.

The reference to *Shoff* does not anticipate the claims. Examiner Ma is correct — *Shoff* communicates a “target specification” with EPG data. As claims 1, 16, and 30 recite, however, *Shoff* fails to teach “stripping the data tag from the programming.” The patent to *Shoff* also fails to teach “communicating the control data to a consumer electronics device to supplement the programming.” As *Shoff* explains, “the target specifications can be in the form of memory pointers, hyperlinks, URLs, or any other designation for **referencing a location containing supplemental content.**” U.S. Patent 6,240,555 to *Shoff et al.* (May 29, 2001) at column 6, lines 53-56 (emphasis added). See also *id.* at column 9, lines 23-26. The patent to *Shoff* only contemplates location references for supplemental content. No where does *Shoff* teach or suggest all the features recited in claims 1, 16, and 30. Because *Shoff* is silent to such features, the patent to *Shoff* cannot anticipate the claims.

Moreover, *Shoff* fails to anticipate claim 10. Claim 10 recites “communicating a data tag that has been added to the electronic program guide data, the data tag comprising a command and a parameter, the command comprising an instruction to send a control instruction to a consumer electronics device.” The patent to *Shoff* only contemplates pointers, links, and other location references for supplemental content. *Shoff* fails to teach that “commands” and “control instructions” can be added to electronic program guide data. Because *Shoff* is silent to such

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features, the patent to *Shoff* cannot anticipate the claims. The Assignee, then, respectfully requests that Examiner Ma remove the § 102 rejection.

**Rejection of Claim 5 under 35 U.S.C. § 103 (a)**

Claim 5 is not obvious. Claim 5 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shoff* in view of Published U.S. Patent Application 2002/0073424 to Ward *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8<sup>th</sup> Edition) (hereinafter "M.P.E.P.").

Claim 5 is not obvious. Claim 5 depends from claim 1 and incorporates the same distinguishing features. The proposed combination of *Shoff* and *Ward* still fails to teach or suggest "*stripping the data tag from the programming.*" The proposed combination of *Shoff* and *Ward* also fails to teach "*communicating the control data to a consumer electronics device to supplement the programming.*" Claim 5, then, cannot be obviated by the proposed combination of *Shoff* and *Ward*. Examiner Ma is respectfully requested to remove the § 103 rejection.

**Rejection of Claims 8-9, 12-14, 18, & 24-25 under 35 U.S.C. § 103 (a)**

Claims 12 and 18 have been cancelled, so the rejection of these claims is moot.

Claims 8-9 are not obvious. These claims were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shoff* in view of U.S. Patent 6,008,802 to Iki *et al.* Claim 8 & 9 depend from claim 1 and, thus, incorporate the same distinguishing features. Claim 8 & 9, for example, include the features "*stripping the data tag from the programming*" and "*communicating the control data to a consumer electronics device to supplement the programming.*" The proposed

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combination of *Shoff* and *Iki* fails to teach or suggest these features, so claims 8-9 cannot be obviated by *Shoff* and *Iki*. Examiner Ma is respectfully requested to remove the § 103 rejection.

Claims 13 and 14 are not obvious. These claims were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shoff* in view of U.S. Patent 6,008,802 to *Iki et al.* Claim 13 and 14 depend from claim 10 and, thus, incorporate the same distinguishing features. Claim 13 and 14, for example, include the features “communicating a data tag that has been added to the electronic program guide data, the data tag comprising a command and a parameter, the command comprising an instruction to send a control instruction to a consumer electronics device.” The proposed combination of *Shoff* and *Iki* only contemplates pointers, links, and other location references for supplemental content. *Shoff* and *Iki* fail to realize that “commands” and “control instructions” can be added to electronic program guide data. The proposed combination of *Shoff* and *Iki* fails to teach or suggest these features, so claims 13-14 cannot be obviated by *Shoff* and *Iki*. Examiner Ma is respectfully requested to remove the § 103 rejection.

Claims 24 & 25 are also not obvious. Claims 24 and 25 depend from claim 16 and incorporate the same distinguishing features. Claim 24 & 25, for example, include the features “stripping the data tag from the programming” and “communicating the control data to a consumer electronics device to supplement the programming.” The proposed combination of *Shoff* and *Iki* fails to teach or suggest these features, so claims 24 & 25 cannot be obviated by *Shoff* and *Iki*. Examiner Ma is respectfully requested to remove the § 103 rejection.

The proposed combination of *Shoff* and *Iki* also teaches away from these claims. “A prior art reference that ‘teaches away’ from the claimed invention is a significant factor” when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A prior art reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). “It is improper to combine references where the references teach away from their combination.” M.P.E.P. at § 2145 (X)(D)(2). If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case. See M.P.E.P. at § 2143.01.

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The Examiner's proposed combination changes the principle of operation of *Shoff*. The patent to *Shoff*, as above explained, only contemplates pointers, links, and other location references for supplemental content. The patent to *Iki*, however, operates by an entirely different principle. When *Iki* finds matching data, predetermined functions are performed. As *Iki* explains, a receiver receives information corresponding to broadcast data. See U.S. Patent 6,008,802 to *Iki et al.* (Dec. 28, 1999) at column 4, lines 48-50. That information is compared to target information. See *id.* at column 4, lines 50-51. If a match is found, a predetermined function is performed. See *id.* at column 4, lines 52-58. If *Shoff* were modified, as Examiner Ma proposes, to automatically perform functions matching stored targets, then *Shoff's* principle of operation must be changed to receive the target data, compare the target data, and retrieve the predetermined functions. This proposed configuration changes *Shoff's* principle of operation and is impermissible. Examiner Ma, then, is respectfully requested to remove the § 103 rejection.

**Rejection of Claims 11, 17, & 33 under 35 U.S.C. § 103 (a)**

Claim 11 is not obvious. Claim 11 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shoff* in view of U.S. Patent 6,326,982 to *Wu et al.* Claim 11, however, depends from claim 10 and, thus, incorporates the same distinguishing features. Claim 11, for example, includes the features "*communicating a data tag that has been added to the electronic program guide data, the data tag comprising a command and a parameter, the command comprising an instruction to send a control instruction to a consumer electronics device.*" The proposed combination of *Shoff* and *Wu* fails to teach or suggest these features, so claim 11 cannot be obviated by *Shoff* and *Wu*. Examiner Ma is respectfully requested to remove the § 103 rejection.

Claim 17 is not obvious. Claim 17 depends from claim 16 and incorporates the same distinguishing features. Claim 17, for example, includes the features "*stripping the data tag from the programming*" and "*communicating the control data to a consumer electronics device to supplement the programming.*" The proposed combination of *Shoff* and *Wu* fails to teach or

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suggest these features, so claim 17 cannot be obviated by *Shoff* and *Wu*. Examiner Ma is respectfully requested to remove the § 103 rejection.

Claim 33 is also not obvious. Claim 33 depends from claim 30 and incorporates the same distinguishing features. Claim 33, for example, includes the features "*stripping the data tag from the programming*" and "*communicating the control data to a consumer electronics device to supplement the programming.*" The proposed combination of *Shoff* and *Wu* fails to teach or suggest these features, so claim 33 cannot be obviated by *Shoff* and *Wu*. Examiner Ma is respectfully requested to remove the § 103 rejection.

**Rejection of Claims 20-23 and 28-29 under 35 U.S.C. § 103 (a)**

Claims 20-23 are also not obvious. Claims 20-23 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shoff* in view of U.S. Patent 6,597,405 to Iggulden. Claims 20-23, however, depend from claim 16 and incorporate the same distinguishing features. Claim 20-23, for example, include the features "*stripping the data tag from the programming*" and "*communicating the control data to a consumer electronics device to supplement the programming.*" The proposed combination of *Shoff* and Iggulden fails to teach or suggest these features, so claims 24 & 25 cannot be obviated by *Shoff* and Iggulden. Examiner Ma is respectfully requested to remove the § 103 rejection.

Claims 28-29 are also not obvious. Claims 28-29 were also rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shoff* in view of Iggulden. Claims 28-29, however, depend from claim 1. The proposed combination of *Shoff* and Iggulden still fails to teach or suggest "*stripping the data tag from the programming.*" The proposed combination of *Shoff* and Iggulden also fails to teach "*communicating the control data to a consumer electronics device to supplement the programming.*" Claims 28-29, then, cannot be obviated by the proposed combination of *Shoff* and Iggulden. Examiner Ma, then, is respectfully requested to remove the § 103 rejection.

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**Rejection of Claims 26-27 under 35 U.S.C. § 103 (a)**

Claims 26-27 are not obvious. Claims 26-27 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Shoff*. Examiner Ma asserts that motion simulators and aroma generators are "notoriously" well known. Whether or not this assertion is true, claims 26 and 27 are not claiming such devices. Claims 26 and 27, instead, receive, strip, process, and communicate an instruction to configure such devices. As this response above explains, *Shoff* is entirely silent to such features. One of ordinary skill in the art, then, would not think claims 26 and 27 are obvious in view of *Shoff*. Examiner Ma, then, is respectfully requested to remove the § 103 rejection.

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If any questions arise, the Office is requested to contact the undersigned at (919) 387-6907 or [scott@scottzimmerman.com](mailto:scott@scottzimmerman.com).

Respectfully submitted,



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